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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,569	08/31/2001	Bertrand Berthelot	1807.1743	9399
5514	7590	11/03/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			STEVENS, ROBERT	
		ART UNIT	PAPER NUMBER	
			2162	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/942,569	BERTHELOT ET AL.
	Examiner Robert Stevens	Art Unit 2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 September 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 19-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 19-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The Office substantially maintains the previous rejections of the claims under 35 U.S.C. §103(a), in light of the amendment. The Office withdraws the previous rejections of the claims under 35 U.S.C. §112-2<sup>nd</sup> paragraph, in light of the amendment. However, the Office has set forth new rejections under 35 U.S.C. §112-2<sup>nd</sup> paragraph, in light of the amendment.

### ***Response to Arguments***

2. Applicant's arguments on page 5 of the amendment with respect to the rejection of claim 22 under 35 USC §112-2<sup>nd</sup> paragraph have been considered but are moot in view of the amendment.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/16/2006 has been entered.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 19-24 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 19** is rejected under 35 U.S.C. §112; second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a means that orders documents. It is noted that the claim recites determining an order, yet does not positively recite “ordering of the documents”.

**Claim 23** is rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a means that orders documents. It is noted that the claim recites determining an order, yet does not positively recite “ordering of the documents”.

**Claims 20-22 and 24** are dependent upon claims 19 and 23, respectively, and therefore likewise rejected.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 19-24 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Tso (US Patent No. 6,959,318 filed Mar. 6, 1998 and issued Oct. 25, 2005, hereafter referred to as "Tso") view of Mäkipää et al. (US Patent No. 6,556,217 filed Jun. 1, 2000 and issued Apr. 29, 2003, hereafter referred to as "Mäkipää").

**Regarding independent claim 19,** Tso discloses: ***A server for providing a document via a network, (See Tso Abstract and Figure 1.) comprising: determining means for determining an order for adapting documents for outputting the documents according to a frequency of access to the documents;*** (See Tso col. 7

lines 50-51, teaching the probability that a page will be accessed, and col. 7 line 65 – col. 8 line 7, discussing the use of “access frequency information” to determine how popular a link is.) ***adapting means for adapting for output, the documents in said determined order before receiving a request for access to a document;*** (See Tso col. 6 lines 55-60 and col. 7 lines 43-55, discussing transcoding prior to a request based upon link popularity.) ***reading means for reading out an adapted document upon reception of a request for access to said document;*** (See Tso col. 6 lines 49-67, discussing storing and reading out of an adapted document.) ***and sending means for sending the document read out to the user terminal.*** (See Tso Figure 1, shows a full duplex communication path between client 20 and server 35 via the Internet.)

However, Tso does not explicitly disclose the remaining limitations. Mäkipää, though, discloses ***receiving means for receiving characteristics related to a user terminal; in accordance with the characteristics related to the user terminal,*** (See Mäkipää Figure 3 #160 and col. 3 lines 14-20 and col. 6 lines 28-40, teaching the reception of terminal characteristics.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Mäkipää for the benefit of Tso, because to do so would have allowed a user to view content regardless of the user's terminal screen size, as taught by Mäkipää in the Abstract. These references were all applicable to the same field of endeavor, i.e., transcoding of networked-served documents.

**Regarding claim 20,** Tso discloses use of a threshold based upon document access. (See Tso col. 7 lines 55-60, discussing a "cut off probability" [i.e., a threshold]. Tso further discloses the use of "access frequency information" to determine how popular a link is in col. 7 line 65 – col. 8 line 7.)

**Regarding claim 21,** Tso discloses adapting all server documents. (See Tso col. 6 lines 49-60, discussing transcoding all documents by a proxy server.)

**Regarding claim 22,** Tso does not explicitly disclose these limitations. Mäkipää, though, discloses the use of screen size user terminal characteristics. (See Mäkipää Abstract, teaching the use of terminal screen size, and col. 3 lines 14-19, discussing calculation of displayspace based upon user terminal screen size.)

**Independent claim 23** is directed to a method implemented by the means of the server of independent claim 19. As such, this claim is substantially similar to claim 19 and likewise rejected.

**Claim 24** is directed to a computer readable medium storing a program to implement the method of claim 23. As such, this claim is substantially similar to claim 23 and likewise rejected.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patents**

Cleron et al.	7,076,534
Johnson et al.	6,248,996
Sumita et al.	6,092,091
Narayen et al.	6,035,323
Konig et al.	6,981,040
Dutta et al.	6,993,476
Kanevsky	6,300,947
Orton	6,590,674
Saksena	6,023,726
Yoda	5,890,173
Guck	5,911,776
Mighdoll et al.	5,918,013

***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Stevens whose telephone number is (571) 272-4102. The examiner can normally be reached on M-F 6:00 - 2:30.

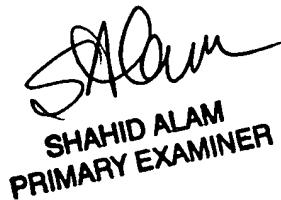
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert Stevens  
Examiner  
Art Unit 2162

October 20, 2006



SHAHID ALAM  
PRIMARY EXAMINER